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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,974	01/22/2004	Hassan Pajouhesh	381092001600	7894

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MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

EXAMINER

KOSACK, JOSEPH R

ART UNIT	PAPER NUMBER
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1626

MAIL DATE	DELIVERY MODE
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11/28/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/763,974	PAJOUHESH ET AL.	
	Examiner	Art Unit	
	Joseph Kosack	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 18-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16 and 23 is/are rejected.
- 7) ☒ Claim(s) 15, 17, 21 and 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-23 are pending in the instant application.

Amendments

The amendment filed on September 13, 2007 has been acknowledged and has been entered into the record.

Previous Claim Objections

Claims 1-17 and 21-23 were objected to in the previous actions for containing elected and non-elected subject matter. The non-elected subject matter has not been cancelled yet, therefore the objection stands. The scope of elected subject matter will be expanded upon the removal of all art rejections on the elected group.

Previous Claim Rejections - 35 USC § 103

Claims 1-14, 16 and 23 were previously rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroita et al. (USPN 6,468,998).

Applicant has traversed the rejection on the grounds that the decision in Takeda v. Alphapharm mirrors the instant case and therefore the instant case is non-obvious, that the Examiner's suggested compound is not within the Applicant's genus, and that there is no suggestion to make the change suggested by the Examiner.

The Examiner respectfully disagrees. Takeda differs from the instant case in two respects. Firstly, there were two required changes to go from the prior art compound to the patented compound. Those were to change a methyl group to an ethyl group and to migrate the ethyl group to another position on a ring also known as "ringwalking." The instant case only requires one modification, and that modification has been held

consistently in the courts to be obvious, that being replacing a hydrogen with a methyl group. Therein lies the suggestion to make the change. In fact, Kuroita et al. do not teach away from using Example 74 for the intended purpose of treating disorders associated with antagonization of the 5-HT₂ receptor. Therefore, one of skill in the art could easily select Example 74 for further study. Finally, the only threshold that Kuroita et al. did not meet with Example 74 was the proviso that that L¹ must contain at least three linking atoms if X¹ is CH and W is L²-A³. Since the suggested compound would have X¹ as CCH₃ and not CH, the proviso would not be triggered and L¹ could contain less than three linking atoms. Therefore, the suggested compound is within the claimed genus. The rejection is maintained.

Claim Objections

Claims 1-17 and 21-23 are objected to for containing elected and non-elected subject matter. The elected subject matter is described in the previous action.

Claims 15, 17, and 21-22 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

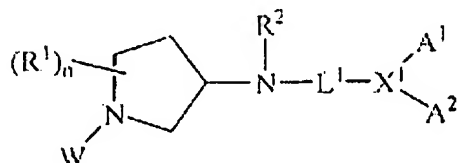
The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-14, 16 and 23 rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroita et al. (USPN 6,468,998).

The instant application claims compounds of the formula

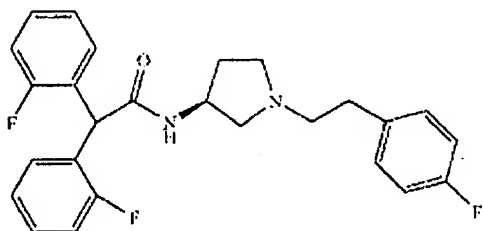


where: W is L²-A³; L¹ and L² are optionally substituted

C₁-C₅ alkylene with no carbons replaced by a heteroatom; A¹, A², and A³ are phenyl; X¹ is CR³; and all other substituents are as defined.

Determination of the scope and content of the prior art (MPEP §2141.01)

Kuroita et al. teach a compound of the formula



See column 32, lines 5-14 and column 45, lines 12-21. This corresponds to the compounds of the instant invention where W is L²-A³; L¹ and L² are optionally substituted C₁-C₅ alkylene with no carbons replaced by a heteroatom; A¹, A², and A³ are phenyl; X¹ is CR³; and all other substituents are as defined. Kuroita et al. also teach the pharmaceutical composition. See column 5, lines 50-53.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

Kuroita et al. do not teach compounds that meet the proviso that L¹ must contain at least three linking atoms if X¹ is CH and W is L²-A³.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

Hydrogen and methyl are obvious variants as they are isotopes of the same element. A compound in which methyl is swapped for hydrogen would be expected to have similar properties to the parent molecule. The court in In re Wood, Whittaker, Stirling, and Ohta (199 USPQ 137) state that compounds with similar structures are expected to have similar properties unless there is evidence on the record of secondary considerations. Therein lies the motivation and a reasonable expectation of success to

change X¹ from CH to CCH₃. As the disclosure does not contain any unexpected results of the presently claimed compounds, they are deemed to be obvious variants over the compounds of Kuroita et al.

Thus, the claimed invention as a whole was *prima facie* obviousness over the combined teachings of the prior art.

Conclusion

Claims 1-14, 16 and 23 are rejected. Claims 1-17 and 21-23 are objected to.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

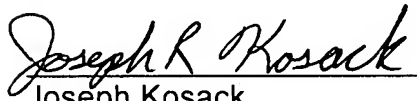
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Kosack whose telephone number is (571)-272-5575. The examiner can normally be reached on M-F 6:30 A.M. until 4:00 P.M. The examiner has every other Friday off.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph M^cKane can be reached on (571)-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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